

Doc# Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

DN801001

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 3/9/06Signature Typed or printed name Charles R. Szmanda

Application Number

09/982,640

Filed

10/18/2001

First Named Inventor

Jeffrey P. Szmanda

Art Unit

2171

Examiner

Cam-Linn Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

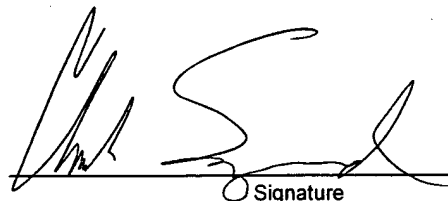
attorney or agent of record. 48,618

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

Charles R. Szmanda

Typed or printed name

508 836 4143

Telephone number

3/9/06

Date

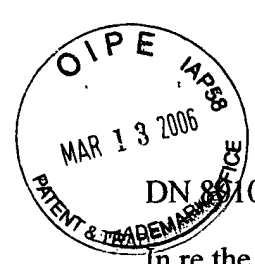
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DN 801001

In re the Application of:

Jeffrey P. Szmanda

Serial No.: 09/982,640

Filed: 10/18/2001

For: A Method of Retrieving Advertising

Information and Use of the Method

) Group Art Unit: 2171

) Examiner: Cam-Linn Nguyen

Mail Stop: AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Pre Appeal Brief Request for Review**

Applicant is in receipt of Examiner's Advisory Action dated 2 March, 2006. Claims 1-42 and 44 are pending in this application. However, Applicant did not and does not request entry of amendments after final as indicated by Examiner. No amendments after final were submitted by Applicant.

Per the USPTO memo: "New Pre-Appeal Brief Conference Pilot Program," dated 12 July, 2005, Applicant submits an index to the documents of record on which he relies in this paper:

Paper Number	Description
Paper 1	Applicant's specification, claims and drawings (as amended), filed 18 March, 2001.
Paper 2	Examiner's First Office Action, pp. 1-11, dated 12 April, 2004.
Paper 3	Applicant's Response to First Office Action, pp.1-41, dated 19 December, 2004.
Paper 4	Examiner's Final Rejection , pp. 1-11, dated 9 November, 2005.
Paper 5	Applicant's request for reconsideration, pp. 1-5, dated 9 February, 2006.
Paper 6	Examiner's Advisory Action, pp. 1-2, dated 2 March, 2006.
Paper 7	US6,098,065 to Skillen et al.
Paper 8	US6,421,652 to Loeb et al.

**Remarks**

**1. BRIEF SUMMARY OF THE INVENTION**

The following is a concise explanation of the invention, which explanation is not intended to limit the scope of the claims to the embodiments shown and described in this paper.

The instant invention relates to a system for a method of retrieving stored information about advertisements, presented in any medium, the use of the method for the purpose of response facilitation, and the use of the method for the purpose of performing demographic research. Pursuant to the object of this invention, the user must supply **facts about an advertisement** and access a database comprising **details of a plurality of advertisements**. The facts about an advertisement may be highly specific, relating to the advertised product or entirely general, such as relating to where the advertisement was experienced (radio, television, billboard, etc. or not at all), the type of advertisement (commercial, infomercial etc.), what was depicted in the advertisement (such as "A woman was climbing stairs and walking fast.") and so on (Paper 1 at Figure 7 and Example 1, ¶ 57). In addition, the invention can be used to perform demographic research by supplying terms **having targeted connotative significance** and accessing a database comprising details of a plurality of advertisements. Various refinements, methods of search, methods of database access and the like are presented in the specification and claims.

**2. GROUNDS OF REJECTION**

Claims 1-42 and 44 stand rejected under 35USC §102(b) as being unpatentable over US6,098,065 to Skillen et al.

Claims 1-10, 39-43 stand rejected under 35USC §102(e) as being unpatentable over US6,421,652 to Loeb et al.

Claims 11-38 stand rejected under 35USC §103(a) as being unpatentable over US6,421,652 to Loeb et al.

**Rejection of claims 1, 11, 25, 39 and 42 as being unpatentable over Skillen.** The following is a quotation from In re Marshall 198 USPQ 344,346 (CCPA 1978): "[r]ejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art." As per claims 1 and 11, Examiner improperly rejected the aforesaid claims citing Skillen (Paper 7 at col. 4 lines 5-6 and col 2, lines 11-33), alleging that "Clearly information that the user searches for is advertising information." However, as Skillen is

understood, the reference discloses a method of generating targeted advertisements to a user who is searching for various reasons using general search terms; the targeted ads are those such as might be seen in the “Sponsored Links” of a Google search when one enters the term “patent law,” for example. Indeed, nowhere does Skillen specify exactly what the user is searching for except to say that the user is searching for “information” (col. 2, line 30) or “desired information” (Abstract, col. 1, lines 40, 51, 59, col. 2, line 4, Claim 1). Examiner’s assertion is merely speculation about an ambiguous reference and an ambiguous reference will not support a 102 rejection. In re Hughes, 345 F.2d 184, 145 USPQ 467 (CCPA 1965). In contrast, Applicant’s claims 1, 11 and 25 particularly point out that the user supplies **“facts about an advertisement”**. Further, as is particularly pointed out in claims 1, 11, 25, 39 and 42 that the database accessed by the user through at least one search engine comprises **“details of a plurality of advertisements”**. A database comprising “details of a plurality of advertisements” is not found in Skillen. As pointed out by Applicant (Paper 3 at pp. 7-8) Skillen’s “contextual database” “typically contains information relating to the Internet, for instance, keywords associated with respective www site locations.” Further Skillen’s disclosure describes a “product database”, presumably having information about products. The databases disclosed in Skillen do not comprise “details of a plurality of advertisements.” A description specifying a database having “details of a plurality of advertisements” is not the same as a “product database” because an advertisement for a product is not the same as the product it advertises. Further, Claim 25 particularly points out: **“generating a second list of keywords, said second list comprising keywords or phrases synonymously related to one or more keywords or phrases in said first list; using said second list and a second search engine to query said first subset; and reporting, to the user, results comprising a second subset of the contents of said database”** (Paper 1 Claim 25 as supported in ¶ 37.). As pointed out by Applicant, (Paper 3, at pp. 18-20). Examiner did not demonstrate that the above limitation can be found in Skillen and failed to do so subsequently in Papers 4 or 6. Accordingly, applicant believes that he has traversed the rejections of claims 1, 11 and 25 on multiple grounds.

As per claims 39 and 42, both claims recite **“accessing a database comprising details of a plurality of advertisements”** as well as **“receiving a list of search terms comprising words having connotative**

**significance to a targeted demographic segment**". The former limitation is not found in Skillen, while the latter limitation does not appear in Examiner's citation (Paper 3 at page 6 and Paper 7 at col. 2, lines 44-49) or anywhere else in Skillen. Applicant pointed out this fact (Paper 3 at pp. 20-21, Paper 5 at pp. 3-4). In Examiner's advisory action (Paper 6, at page 2), Examiner stated that "the term connotative has the meaning of argument, according to the online dictionary." **Applicant respectfully requests that Examiner supply the full reference to "the online dictionary," including the publication date, wherein is recited "connotative has the meaning of argument."** Moreover, Applicant asserts his right to be his own lexicographer under MPEP §2111.02 (III) and references contained therein. Applicant has supplied his own definition of "connotative" (Paper 1 at ¶ 18) which cannot be superseded by examiner's definition. The rejections of claims 39 and 42 are traversed on multiple grounds.

**Rejection of claims 1, 39 and 42 as being unpatentable over Loeb under 35USC §102(e) and claims 11 and 25 as being unpatentable over Loeb under 35USC §103(a).** Once again, the "all limitations rule" applies for anticipation rejections as set forth in MPEP §2131. Further, establishing a prima facie case of obviousness must meet the criteria set forth in MPEP §2142 and references cited therein.

As pointed out in Paper 3 at page 22, and in paper 5 at pp 4-5, Loeb does not "disclose[s] a method of supplying advertisement information to a user..." as alleged by Examiner (Paper 2 at page 7). Instead, Loeb discloses a "method and system for providing free subscriptions to magazines based on a universal questionnaire" (Paper 8 at Abstract). This is not the same invention disclosed in the instant application. As was pointed out by Applicant on two occasions (Paper 3 at pp. 22-23 and Paper 5 at pp. 4-5), nowhere in Loeb is disclosed or suggested **"receiving, from the user, a series of search rules comprising facts about an advertisement."** (Paper 1 at claims 1,11,25) Further, nowhere in Loeb is disclosed or suggested a **"database comprising details of a plurality of advertisements"** (Paper 1 at Claims 1, 11, 25, 39, 42). Further Nowhere in Loeb is disclosed or suggested **"receiving a list of search terms comprising words having connotative significance to a targeted demographic segment"** (Paper 1 at Claims 39, 42). Further, nowhere in Loeb is disclosed **"generating a second list of keywords, said second list comprising keywords or phrases synonymously related to one or more**

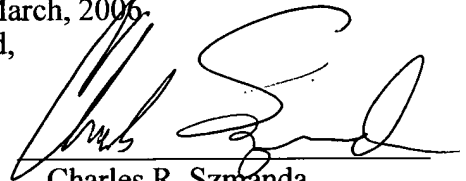
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**keywords or phrases in said first list; using said second list and a second search engine to query said first subset; and reporting, to the user, results comprising a second subset of the contents of said database”**

(Paper 1 at claim 25). Traversal of the 102(e) rejections based on Loeb has been documented amply (Paper 3 at pp. 22-25, pp. 31-33 and Paper 5, pp. 4-5). Examiner’s rejections repeatedly describe the Loeb reference as disclosing “a method for supplying advertisement information to a user searching for said information within a data network” or in shortened form, “an advertising system” (Paper 2 at page 7, Paper 4 at Page 10). Those assertions are both factually inaccurate (as discussed supra) and irrelevant because all elements of the claims must be disclosed or inherent in the reference. They are not. Further, as per Claims 11 and 25, traversal of the 103(a) rejections has been amply documented (Paper 3, pp. 34-37). Examiner did not reply to Applicant’s arguments regarding the 103(a) rejections in either of Papers 4 or 6. The rejections of record based on the Loeb reference have been traversed.

**Dependent Claims.** Claims 2-10 depend from claim 1. Claims 12-24 depend from claim 11. Claims 26-38 depend from Claim 25. Claims 40-41 depend from Claim 39. Claim 44 depends from claim 42. Therefore, the dependent claims include all of the limitations set forth in the claims from which they depend. Accordingly, applicant submits that rejection of the dependent claims is improper.

Dated this 9<sup>th</sup> day of March, 2006.  
Respectfully submitted,



Charles R. Szmanda  
Agent for Applicant  
Registration # 48,618  
Telephone: 508 836 4143  
FAX: 508 836 4143

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to “Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450” [37 CFR 1.8(a)]

On 3/9/06

  
Charles R. Szmanda